

### **THE OFFICE ACTION**

In the Final Office Action issued on April 7, 2004, the Examiner rejected claims 1-3, and 6-20 under 35 U.S.C. §112, first paragraph, for scope of enablement. The Examiner also rejected claims 1-7, and 9-20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. The Examiner rejected claims 1-6, 9-13, 17 and 20 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,317,540 to Wakeman ("Wakeman"). The Examiner further rejected claims 1-10 and 20 under 35 U.S.C. §102(b) as being anticipated by DE19712565. The Examiner also rejected claims 1-20 under 35 U.S.C. §102(b) as being anticipated by WO 91/07876 to Vandeveld et al ("Vandeveld"). The Examiner also rejected claims 1-20 under 35 U.S.C. §102(b) as being anticipated DE4137544 to Harwardt et al. ("Harwardt").

### **REMARKS**

Applicants have carefully considered the Final Office Action issued on April 7, 2004. Applicants respectfully request reconsideration of the application in light of the above amendments and the following comments.

#### **A. Claims 1-20 Comply with 35 U.S.C. §112**

The Examiner rejected claims 1-3 and 6-20 under 35 U.S.C. §112, first paragraph, for scope of enablement as not reasonably providing enablement for treating any "diseases of the skin and mucous membranes, organs, tissues except for retroviral HIV diseases and disinfection." Specifically, it is the Examiner's position that a person of skill in the art would have to engage in undue experimentation to test the instant compound for treating any skin diseases. Applicants submit that amendments made to claims 1 and 20 now render such a rejection moot. Specifically, the amended claims are now limited to the treatment of diseases for which an enablement is provided in the specification. The Examiner is directed to tables on pages 13 and 14 of the specification as well as the discussion on page 3, paragraph 2 of the application, where a successful treatment of all diseases specifically claimed in amended claims 1 and 20 are described. In light of the above, withdrawal of this rejection is respectfully requested.

The Examiner also rejected claims 1-7, and 9-20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Specifically, the Examiner stated that since the recitations "their derivatives" and "decomposition products" are not defined in the specification, one of ordinary skill in the art could not interpret the metes and bounds of the claims. Applicants submit that amendments made to the appropriate claims now render such a rejection moot.

Specifically, Applicants have amended the relevant claims to remove the recitation of "their derivatives" and "decomposition products". In light of the above, withdrawal of this rejection is respectfully requested.

**B. The Pending Claims Are Not Anticipated by Wakeman**

The Examiner rejected claims 1-6, 9-13, 17 and 20 under 35 U.S.C. §102(b) as being anticipated by Wakeman. Applicants respectfully traverse.

Wakeman is directed to the use of quaternary ammonium aromatic sulfonamides for disinfection and as bacteriostat agents (col. 3, line 13 – col. 4, line 15). Wakeman neither discloses nor suggests a method for the treatment of the specifically claimed diseases by administering tosylchloramide(s), tosylchloramide salt(s), and mixtures thereof. Despite the Examiner's arguments, Wakeman's method steps do not "inherently treat the instant particular skin diseases" because Wakeman not only does not disclose or suggest the treatment of these specific diseases, but also does not teach applying compounds to the area of skin or other tissue that is infected with these diseases. In addition, the Examiner's statement that "the claiming of a new use, new function or unknown property which is inherently present in the prior art does not make the claim patentable" is only applicable to composition claims. Such an argument is inapplicable to method claims utilizing such compositions. That is, a new and unobvious use for an otherwise old structure [or composition] is patentable. *In re Hack*, 114 USPQ 161, 163 (CCPA 1957). See also MPEP, §2112.02. Thus, applicants submit that Wakeman fails to anticipate the present claims.

**C. The Present Claims Are Not Anticipated by DE1971256**

The Examiner rejected claims 1-10 and 20 under 35 U.S.C. §102(b) as being anticipated by DE1971256. Applicants respectfully traverse.

DE1971256 is directed to a composition containing an agent which generates Singulett-oxygene and photons, respectively, and a process for the treatment of blood and blood products with said composition. DE1971256 neither discloses nor suggests a method for the treatment of the specifically claimed diseases (i.e. psoriasis, neurodermatitis, shingles, aphthae, lip rhagade, stomatitis herpetica, vessels with watery liquid, tinea pedis, and diseases of the skin and mucous membrane caused by herpes simplex virae including herpes labialis and herpes genitalis) by administering tosylchloramide(s), tosylchloramide salt(s), and mixtures thereof.

Despite the Examiner's arguments, DE1971256 method steps do not "inherently treat the instant particular skin diseases" because DE1971256 not only does not disclose or suggest the treatment of these specific diseases, but also does not teach applying compounds to the area of skin or other tissue that is infected with these diseases. In addition, and as detailed above with respect to Wakeman, the Examiner's statement that "the claiming of a new use, new function or unknown property which is inherently present in the prior art does not make the claim patentable" is only applicable to composition claims. Such an argument is inapplicable to method claims utilizing such compositions. That is, a new and unobvious use for an otherwise old structure [or composition] is patentable. Thus, applicants submit that DE1971256 fails to anticipate the present claims.

**D. The Present Claims Are Not Anticipated by Vandevælde**

The Examiner rejected claims 1-20 under 35 U.S.C. §102(b) as being anticipated by Vandevælde. Applicants respectfully traverse.

Vandevælde is directed to an agent which acts against retrovirus group viruses, whereby the agent consists of a chlorinated organic compound which stably and lastingly releases chlorine when in solution. Vandevælde neither discloses nor suggests a method for the treatment of the specifically claimed diseases (i.e. psoriasis, neurodermatitis, shingles, aphthae, lip rhagade, stomatitis herpetica, vessels with watery liquid, tinea pedis, and diseases of the skin and mucous membrane caused by herpes simplex virae including herpes labialis and herpes genitalis) by administering tosylchloramide(s), tosylchloramide salt(s), and mixtures thereof.

Despite the Examiner's arguments, Vandevælde's method steps do not "inherently treat the instant particular skin diseases" because Vandevælde not only does

not disclose or suggest the treatment of these specific diseases, but also does not teach applying compounds to the area of skin or other tissue that is infected with these diseases. In addition, and as detailed above with respect to Wakeman, the Examiner's statement that "the claiming of a new use, new function or unknown property which is inherently present in the prior art does not make the claim patentable" is only applicable to composition claims. Such an argument is inapplicable to method claims utilizing such compositions. That is, a new and unobvious use for an otherwise old structure [or composition] is patentable. Thus, applicants submit that Vandeveld fails to anticipate the present claims.

**E. The Present Claims Are Not Anticipated by Harwardt**

The Examiner rejected claims 1-20 under 35 U.S.C. §102(b) as being anticipated by Harwardt. Applicants respectfully traverse.

Harwardt is directed to the use of an oxygen generating compound as an antiseptic and for disinfection (see page 2, lines 3 and 4). Harwardt neither discloses nor suggests a method for the treatment of the specifically claimed diseases (i.e. psoriasis, neurodermatitis, shingles, aphthae, lip rhagade, stomatitis herpetica, vessels with watery liquid, tinea pedis, and diseases of the skin and mucous membrane caused by herpes simplex virae including herpes labialis and herpes genitalis) by administering tosylchloramide(s), tosylchloramide salt(s), and mixtures thereof.

Despite the Examiner's arguments, Harwardt's method steps do not "inherently treat the instant particular skin diseases" because Harwardt not only does not disclose or suggest the treatment of these specific diseases, but also does not teach applying compounds to the area of skin or other tissue that is infected with these diseases. In addition, and as detailed above with respect to Wakeman, the Examiner's statement that "the claiming of a new use, new function or unknown property which is inherently present in the prior art does not make the claim patentable" is only applicable to composition claims. Such an argument is inapplicable to method claims utilizing such compositions. That is, a new and unobvious use for an otherwise old structure [or composition] is patentable. Thus, applicants submit that Harwardt fails to anticipate the present claims.

**CONCLUSION**

In view of the foregoing comments, Applicants submit that claims 1-20 are in condition for allowance. Applicants respectfully request early notification of such allowance. Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned to attempt to resolve any such issues.

If any fee is due in conjunction with the filing of this response, Applicants authorize deduction of that fee from Deposit Account 06-0308.

Respectfully submitted,

**FAY, SHARPE, FAGAN,  
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Date: \_\_\_\_\_

July 6, 2004

  
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